

R1994-10

In re)
) Decision on Petition
) for Review under
) 37 CFR § 10.2(c)
)

(petitioner) seeks review of the decision of the Director of the Office of Enrollment and Discipline (OED), dated October 7, 1993, which denied the petitioner's request for higher scores on Part I of the afternoon section of the Registration Examination for Patent Attorneys and Agents held on April 21, 1993. The petition is denied.

The afternoon section of the examination consist of two parts. Part I consists of a claim drafting question worth 60 points. Part II consists of 8 multiple choice questions worth 5 points each. To pass the afternoon section of the examination, 70 points had to be achieved.

The petitioner had 20 points deducted from his score for answering four multiple choice questions incorrectly. On the claim drafting question, 20 points were deducted. Accordingly, the petitioner achieved a combined score of only 60 points for the afternoon section of the examination.

On September 27, 1993, the petitioner requested the Director of OED to reconsider the grading of the claim drafting question. A supplement to the request was filed on September 30, 1993. The Director, on October 7, 1993, issued a

reconsideration decision, determining that the petitioner was not entitled to any additional points on the claim drafting question.

Opinion

A. The claim drafting question

In answering the claim drafting question, the petitioner had an option to work with any one of three different disclosed inventions -- a mechanical invention, a chemical invention, and an electrical invention. The petitioner chose the mechanical invention which is directed to a patio door wheel assembly.

A specification of the invention was provided by the question, including a paragraph entitled OBJECTS OF THE INVENTION, a drawing of prior art and corresponding written description, two figures showing respective embodiments of the invention, and detailed written description of the two embodiments of the invention. The question further contained these instructions:

Draft THREE (3) CLAIMS: a single independent claim and two dependent claims to a wheel assembly for a patio door. The generic claim (claim 1) must be the broadest claim for the wheel assembly which defines the invention as set forth in the OBJECTS OF THE INVENTION, which includes any critical limitations, and which is not anticipated by the prior art. One dependent claim (claim 2) must cover the specific embodiment shown in FIG. 2. The other dependent

claim (claim 3) must cover the specific embodiment shown in FIG.3, including the tire.

Your claims must be drawn to a wheel assembly for a patio door, and you must adhere to the following requirements. You may not be your own lexicographer to name the elements or components of the disclosed invention or to rename elements or components of the wheel assembly. Thus, you must use the terminology of the described invention. Any method claim or Jepson claim will receive no credit. Points will be deducted for (1) claiming subject matter not within the scope of the invention disclosed above; (2) using claim language which is vague or indefinite, e.g., language which does not have antecedent basis or which does not positively set forth each element or component; (3) failing to interrelate or incorrectly interrelating the elements or components in your claims in the manner disclosed and shown above; (4) claiming unnecessary limitations in claim 1; (5) presenting a claim that defines an inoperative invention or is anticipated by the prior art; (6) using poor grammar; and (7) failing to follow these directions. [Emphasis in original.]

Accordingly, based on the above-quoted instructions, claim 1 should be the broadest claim:

- (a) which still defines the invention as set forth in the
OBJECTS OF THE INVENTION paragraph;
- (b) which includes any critical limitations; and
- (c) which is not anticipated by prior art.

B. Points deducted for not defining the invention
as set forth in the OBJECTS OF THE INVENTION

Three points were deducted from the petitioner's score because petitioner's claim 1 did not recite that the wheel was made of synthetic resin material. The petitioner argues that it is not necessary to have that limitation in claim 1 because (1) the other limitations already distinguish the invention from prior art, and (2) one can avoid a claim having that limitation with a wheel made out of different material. The argument is without merit.

The question directs the petitioner not only to claim an invention not anticipated by prior art but also to draft the claim in such a way that it defines the invention as set forth in the OBJECTS OF THE INVENTION paragraph. To whatever extent the petitioner thinks the OBJECTS OF THE INVENTION paragraph discusses the invention in terms of features more detailed than necessary to define an invention over the prior art, that is of no moment. The petitioner must take the OBJECTS OF THE INVENTION paragraph as it was written, and not disregard it or replace it with his own ideas of what the objectives should be.

In pertinent part, the OBJECTS OF THE INVENTION paragraph states:

Accordingly, the primary object of the present invention is to provide a wheel assembly having side plates rotatably supporting a synthetic resin material wheel upon two spaced sets of ball bearings, with the wheel including annular outer ball races. The wheel assembly is further configured without separate and distinct inner ball race members by using inturned portions of the side plates and the respective plates together to define annular inner ball races.

Based on the OBJECTS OF THE INVENTION paragraph, the invention is expressly limited to a wheel assembly including a wheel made of synthetic resin material. Thus, the correct answer to this claim drafting question, must define in claim 1 that the wheel is made of synthetic resin material. Three points were properly deducted from the petitioner's score, for the petitioner's failing to recite in claim 1 that the wheel is made of synthetic resin material.

One point was deducted from the petitioner's score because petitioner's claim 1 did not recite that the outer ball races of the wheel were annular. The petitioner argues: (1) it is not necessary to recite the "annular" feature to distinguish over prior art which already has annular outer ball races, and (2) it is implicit from Figure 2 of the invention disclosure that the outer ball races must match the contour of the ball

bearing surface they engage. The arguments are misplaced and without merit.

Again, the question instructs the petitioner not only to draft a claim 1 which defines over the prior art but also to draft it in a manner which defines that which is set forth in the OBJECTS OF THE INVENTION paragraph. Because the paragraph sets forth the wheel as having "annular" outer ball races, claim 1 must include the "annular" feature of the outer ball races, notwithstanding whether the feature is required to define over the prior art.

The petitioner notes that the embodiment shown in Figure 2 has annular outer ball races. However, it is impermissible to read limitations into a claim where the claim does not otherwise require them. E.g., In re Priest, 582 F.2d 33, 37, 199 USPQ 11, 15 (CCPA 1978); In re Prater, 415 F.2d 1393, 1404, 162 USPQ 541, 550 (CCPA 1969). Petitioner's claim 1 does not require the outer ball races to be annular. Also, "annular" is not the only possible shape or configuration for ball races, and thus the claimed outer ball races are not implicitly or inherently annular.

C. Points deducted for not reciting
critical features in claim 1

Six points were deducted from the petitioner's score because race liners were not recited in petitioner's claim 1. The question instructed the petitioner to include in claim 1 any critical limitations. The invention disclosure specifically stated: "The presence of the liners is critical

since the synthetic resin material of the wheel is not sufficiently wear resistant for use with ball bearings." Because petitioner's claim 1 did not recite race liners, six points were properly deducted.

The petitioner argues that it is not necessary to recite race liners in claim 1 because that limitation is not necessary to distinguish the invention from the prior art. The petitioner also argues that the OBJECTS OF THE INVENTION paragraph did not discuss any race liners. The arguments are without merit. Per the question's instructions, the petitioner must, in addition to defining the broadest invention not anticipated by the prior art and as set forth in the OBJECTS OF THE INVENTION paragraph, include in claim 1 any critical limitations of the invention.

The OBJECTS OF THE INVENTION paragraph specifies that the wheel is made of synthetic resin material. The specification describes, in connection with the use of race liners, that the synthetic resin material of the wheel is not sufficiently wear resistant for use with ball bearings. Thus, race liners are critical to the invention as set forth in the OBJECTS OF THE INVENTION paragraph.

The petitioner argues that inclusion of race liners in claim 1 is ambiguous, especially if "synthetic resin material" is not included in the claim. But the synthetic resin material limitation should have been included by the petitioner in claim 1. Moreover, there is nothing ambiguous about the race

liners not being expressly discussed in the OBJECTS OF THE INVENTION paragraph. They are appropriately discussed in the specification as being necessary for use with wheels made of synthetic resin material; the OBJECTS OF THE INVENTION paragraph refer to a wheel made of synthetic resin material.

In any event, the specification expressly states that the presence of race liners is "critical." Accordingly, the race liners must be included in claim 1. That they are recited in claim 2 does not remedy the deficiency in claim 1.

Six points were deducted from the petitioner's score for not reciting a connecting means which joins the various claimed parts together in an operative manner. The petitioner argues that since the OBJECTS OF THE INVENTION paragraph discussed no specific connecting means, none can be included in claim 1. The petitioner further argues that without reciting any connecting means, he has claimed an operable combination as set forth in the OBJECTS OF THE INVENTION paragraph and which distinguishes from the prior art. The arguments are without merit.

In addition to claiming an invention as set forth in the OBJECTS OF THE INVENTION paragraph and not anticipated by prior art, the petitioner had to include any critical limitations in claim 1. Features which are necessary to make the invention operative are critical. Moreover, the question's instructions further expressly stated that points will be deducted for presenting a claim which defines an inoperative invention.

Petitioner's claim 1 is inoperative because nothing holds the side plates together or cause them to confine the ball bearings. While the law does not require one to recite any particular connecting means, some connecting means has to be recited if it is necessary to the operability of the claimed invention. A claim which is inoperative as claimed is unpatentable under either 35 U.S.C. § 101 or 35 U.S.C. § 112. See, e.g., Raytheon Co. v. Roper Corp., 724 F.2d 951, 956, 220 USPQ 592, 596 (Fed. Cir. 1983), cert. denied, 469 U.S. 835 (1984).

A connecting means is not implicit or inherent in the claim simply because the preamble of the petitioner's claim recites "A patio door frame wheel assembly," or because it has to be present in order for the claimed invention to operate as a wheel assembly. Otherwise, no critical feature has to be claimed because its presence would always be presumed. For instance, the petitioner could not omit recitation of the wheel on the basis that the claim's preamble already states that the invention is a wheel assembly and that all wheel assemblies have wheels.

A connecting means is necessary for the side plates to achieve the required cooperative relationship in an operative wheel assembly. Accordingly, it must be recited in claim 1.

D. Points deducted for including unnecessary limitations in claim 1

The question's instructions expressly stated that points would be deducted for including unnecessary limitations in

claims. One point was deducted from the petitioner's score for limiting the side plates of claim 1 to those having annular external "arcuate faces." The petitioner argues that this limitation is necessary because it is required to distinguish the claimed invention from the prior art. The petitioner further argues that the limitation must be necessary "or it would not have been included in Fig 2, which is 'a first embodiment of the wheel assembly constructed in accordance with the invention.'" The arguments are without merit.

Figure 2 of the invention disclosure represents merely a particular embodiment of the invention. Not every feature shown in Figure 2 is either critical or required to define over the prior art. To the extent that the petitioner presumes that there is always one disclosed embodiment which includes no more features than those which are necessary to define over the prior art, the presumption is not logical and is without basis in law. The invention of petitioner's claim 1, without the annular external arcuate faces of the side plates, already is distinguished from prior art, based on the two ball bearings, the curved annular internal portions of the side plates, and the external ball races of the wheel.

One point was deducted from the petitioner's score for limiting the wheel assembly of claim 1 to that which has an outer periphery which runs on a guide rail. The petitioner argues that this limitation is necessary. The argument is without merit. The limitation is not necessary to distinguish

the invention from prior art because the claimed features concerning the inner and outer ball races, the inturned portions of the side plates, and the two sets of ball bearings already adequately distinguish the invention over the prior art. Also, the claimed invention without this limitation still constitutes an operative wheel assembly. That the limitation serves a useful purpose in a particular disclosed embodiment does not mean it is a necessary limitation to be included in the broadest claim.

E. Points deducted for failing to distinguish inner and outer ball races

One point was deducted from the petitioner's score for not adequately distinguishing inner and outer ball races when making a reference in clause (g) of claim 1 to first annular ball races. In claim 1, the petitioner has defined first and second inner ball races and first and second outer ball races. It is unclear whether the reference to the first and second annular ball races refer to the inner ball races or the outer ball races. The deduction of one point is proper, since the question's instructions stated that points will be deducted for using claim language which is vague or indefinite. Claims must particularly point out and distinctly claim the subject matter which the applicant regards as the invention. 35 U.S.C. § 112, second paragraph.

The petitioner argues that because the reference at issue appears in clause (g) of claim 1, it refers to the outer ball races defined in the immediately preceding clause, clause (f),

rather than those defined in clause (d), the inner ball races. The argument is without merit. Nothing precludes a claim term from referring back to an element earlier defined anywhere in the claim. There also is no rule that an element can only be further modified in the immediately succeeding clause. Thus, the reference at issue can well refer to either the inner ball races of clause (d) or the outer ball races of clause (f).

Furthermore, the petitioner defined the inner ball races to be annular but did not define the outer ball races to be so. We note that the reference at issue does identify "annular" ball races. That would seem to indicate the reference is directed to the inner ball races defined in clause (d), contrary to the petitioner's contention that the reference is directed to the ball races defined in clause (f). In summary, it is simply unclear whether the reference to ball races is associated with the inner or the outer ball races.

F. Points deducted for failing to comply with 35 U.S.C. § 112, fourth paragraph

One point was deducted from the petitioner's score because petitioner's claim 3 violates 35 U.S.C. § 112, fourth paragraph, which states, in pertinent part:

[A] claim in dependent form shall contain a reference to a claim previously set forth and then specify a further limitation of the subject matter claimed. A claim in dependent form shall be construed to incorporate by reference all the limitations of the claim to which it refers.

Petitioner's claim 3 is dependent from claim 2, and thus must includes all limitations of claim 2. However, in claim 3 the petitioner recites that the invention includes a certain feature "instead" of a feature recited in claim 2. Specifically, claim 2 recites a tubular rivet having outer ends which bear against the external surfaces of the side plates, and claims 3 recites: "said side plates each have a central web portion instead of being connected by a tubular rivet." The above-quoted language of claim 3 makes clear that the side plates are not connected by a tubular rivet, which they must, however, if claim 3 is dependent on claim 2.

The petitioner argues that while claim 2 recites a tubular rivet, claim 3 recites a "simple solid rivet," and that because "solid" and "hollow" are not incompatible, the connecting means for claims 2 and 3 are not incompatible. The argument is misplaced and without merit. First, claim 3 does not recite any "simple solid rivet"; rather, it recites: "said central web portion of each said side plate abut one another and are connected by a simple rivet." Secondly, the compatibility argument fails because claim 3, through the phrase "instead of being connected by a tubular rivet," expressly rules out connection by a tubular rivet.

CONCLUSION

For the foregoing reasons, twenty (20) points were properly deducted from the petitioner's score on Part I of the afternoon section of the registration examination held on April 21, 1993. Accordingly, upon consideration of the petition to the Commissioner, filed under 37 CFR § 10.2(c), it is herein ORDERED that the petition is denied.

A handwritten signature in dark ink, appearing to read "E. R. Kazenske", is written over a horizontal line.

EDWARD R. KAZENSKE
Director of Interdisciplinary
programs

cc:

UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE COMMISSIONER OF PATENTS AND TRADEMARKS

R1994-100

In re

)
) On Request for
) Reconsideration
)

Decision

On December 10, 1993, a decision (copy enclosed) by the undersigned was mailed on a petition filed under 37 CFR § 10.2(c) for review of a determination by the Director of the Office of Enrollment and Discipline (OED) refusing to register for practice before the Patent and Trademark Office (PTO). The Commissioner has delegated authority to decide petitions filed under 37 CFR § 10.2(c) to the Director of Interdisciplinary Programs.

On December 22, 1993, the PTO received a communication with a copy of essentially the same petition from again asking the Commissioner to review the Director's decision that was the basis of the petition under 37 CFR § 10.2(c) which was decided on December 10, 1993.

The communication of December 22, 1993 will be treated as a request for reconsideration. Inasmuch as this communication does not point out or explain why the petition decision of December 10, 1993, was erroneous, it is denied.


EDWARD R. KAZENSKE
Director of Interdisciplinary
Programs

cc: